

REMARKS/ARGUMENTS

Claims 1-28 were pending of which Claims 1-16 were rejected. Claims 1, 4, 7-10 and 15 have been amended and Claims 11 and 17-28 have been cancelled. New Claims 29-40 have been added. Reconsideration is requested.

Drawings

The drawings were objected to under 37 CFR 1.83(a) because they failed to show reference numeral 36, as described on page 11 of the specification, and reference numeral 16, as described on page 12, line 1, of the specification.

The layer 36 is shown in Fig. 5J.

The specification at page 12, line 1, has been amended to conform the specification to Fig. 5J. The reference numeral 16 has been deleted.

Claim Rejections – 35 U.S.C. §112

Claims 1-16 were rejected under 35 U.S.C. §112, second paragraph, on the ground that the claim limitation “substantially determined” is indefinite.

The Applicants respectfully traverse. The specification explains that, in this situation, the “component or components that substantially determine physical properties of the inhomogeneous material do not necessarily entirely determine those properties” (page 4, lines 31-32). Claims that contain terms such as “substantially,” “approximately” or “about” have often been allowed to express conditions or relationships where absolute terms either would be inaccurate or would not provide the protection to which the Applicant is entitled. If the claim is litigated, the court must determine whether the allegedly infringing product or method falls within the scope of the claim. The claim is not considered invalid as indefinite under 35 U.S.C. §112. See York Products, Inc. v. Central Tractor Farm & Family Center, 40 USPQ2d 1619 (Fed Cir. 1996) (“Ordinarily, ... ‘substantially’ means ‘considerable in ... extent,’ American Heritage Dictionary Second College Edition 1213 (2d ed. 1982), or ‘largely but not wholly that which is specified,’ Webster’s Ninth New Collegiate Dictionary 1176 (9th ed. 1983)”); Alcon Laboratories Inc. v. Allergan Inc., 17 USPQ2d 1365, 1369 (N.D. Tex. 1990) (“Given its ordinary and accustomed meaning, substantially all means a large or considerable amount of the whole;

not everything, but almost everything. It does not mean 'some' or 'half' or even 'a majority.'")

The Examiner stated that he was "unable to locate a definition of substantially determined in the specification." In fact, there is ample explanation of this terminology. The following passages are examples:

"Variation in the nature or concentration of the binder components may also affect the physical properties [of the inhomogeneous material], but typically to a lesser degree" than the properties of the "component or components that substantially determine physical properties of the inhomogeneous material." (Page 4, line 31, to page 5, line 2)

"When suitably bound, the porous silica particles substantially determine, for example, the hardness, stability, and dielectric constant of the low k material." (Page 5, lines 13-15)

"[A] binder that increases the spacing between the silica particles may thereby increase interparticle porosity and decrease the dielectric constant of the material," but the "resulting variations in the dielectric constant are typically fairly small and distributed about a value corresponding to that of a material including silica particles but no binder." (Page 5, lines 26-28)

The first of the above-quoted passages is exemplified in Table 1 on page 15. In the cases where the film thickness is 1490Å and 1530 Å, respectively, it may be assumed that the particle concentration is about the same (see page 13, lines 5-7). Yet while the binder concentration increased from 5.2 mg/ml to 9.7 mg/ml, the dielectric constant of the material increased only from 2.5 to 2.97. Clearly, this is a case where the dielectric constant of the material is "substantially determined" by the silicalite particles.

The Examiner indicated that Claims 4, 5, 7, 9 and 10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. §112, second paragraph, and to include all of the limitations of the base claim and any intervening claims. Each of Claims 4, 7, 9 and 10 has been rewritten in independent form to include all of the limitations of the base claim (Claim 1). Claim 5 depends from Claim 4. Accordingly, Claims 4, 5, 7, 9 and 10 are allowable.

Claim Rejections – 35 U.S.C. §102

Claims 1 and 14 were rejected under 35 U.S.C. §102(e) as being anticipated by Nevoret et al.

Claim 1 has been amended by incorporating the limitation of Claim 11 into Claim 1. Since Claim 11 was not rejected over Nevoret, Claim 1 is now allowable over Nevoret. Claim 14 depends from Claim 1 and is therefore also allowable over Nevoret.

Claims 1-3, 6, 8 and 13 were rejected under 35 U.S.C. §102(e) as being anticipated by Jia.

Claim 1 has been amended by incorporating the limitation of Claim 11 into Claim 1. Since Claim 11 was not rejected over Jia, Claim 1 is now allowable over Jia. Claims 2, 3, 6, 8 and 13 depend from Claim 1 and are therefore also allowable over Jia.

Claims 1-3, 11, 12 and 14-16 were rejected under 35 U.S.C. §102(e) as being anticipated by Gaynor. Among other things, the Examiner concluded that "for purposes of this rejection the 'predetermined response to radiation' is no response to radiation."

Claim 1 has been amended to recite "a first component that exhibits a predetermined change in response to radiation," thus overcoming the rejection based on Gaynor. Claim 1, as amended, is therefore allowable over Gaynor. Claims 2, 3, 12, and 14-16 depend from Claim 1 and are also allowable over Gaynor. Claim 11 has been canceled.


Thus, Applicants respectfully submit that Claim 1-10 and 12-16 are patentable over the cited references. Reconsideration and withdrawal of this rejection is respectfully requested.

New Claims 29-40 are supported at least at page 11, line 9, to page 12, line 4, and in Figs. 5A-5M. New Claims 29-40 are allowable for the reasons stated above.

For the above reasons, Applicants respectfully request allowance of Claims 1-10, 12-16 and 29-40. Should the Examiner have any questions concerning this response, the Examiner is invited to call the undersigned at (408) 982-8200, ext. 1.

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3/31/04
Date of Signature

Respectfully submitted,


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